

REMARKS

The Office Action dated December 17, 2003, and made final and the Advisory Action dated February 9, 2004 have been carefully reviewed and the foregoing amendment and following remarks have been made in consequence thereof.

Claims 1-18 are pending in this application. Claims 1-18 stand rejected.

The rejection of Claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Haq et al. "Haq", (U.S. Patent No. 6,275,812) in view of Brady et al., "Brady" (U.S. Patent 6,463,430) is respectfully traversed.

Haq describes a system and method for human resource skill management, training, career development, and deployment for the employees of a company. The system compares the employees' skills to skills required for a position within the company in a one to one correspondence. The method uses skill templates that enable a project manager to compare the employees skills with skills that are required by each member of the project team to assess the employee's suitability for a position. A weighting system is also used to establish the relative significance of various skills. An assessment of an employee's suitability for a project within the company is based on a quantitative evaluation and not based on subjective considerations.

Brady describes an automated method of creating or updating a database of resumes and related documents wherein a resume is defined at column 5, lines 29-31 as being, "a document that contains...information relevant to an individual's work and/or educational experience." Moreover, at column 5, lines 33-36, the term "related documents" is defined as "documents that provide additional information regarding an individuals qualifications and expertise in a particular area, e.g., journal articles, or publications." The method includes retrieving a resume or related document from a network of documents, harvesting information from specified fields of the document, classifying the information into one or more classes, determining whether the information are links to other documents, and ranking the link's according to relevancy. The resumes include one or more desired attributes, such as, technical expertise, years of work experience in an industry, or academic training (type of degree, institution where degree awarded, grade point average, etc.). Notably, Brady does

not describe nor suggest any subjective qualities desired in a candidate, such as analytical ability, self-confidence, initiative, change orientation, and interpersonal skills. Rather, at column 6, lines 1-21, Brady describes that the database is updated with objective qualities “such as, technical expertise, years of work experience in an industry, academic training (type of degree, institution where degree awarded, grade point average, etc.).” Moreover, at column 7, lines 11-19, Brady describes that the invention provides the user with many benefits, including the fact that the “method is automated and performed by computers”, such that “the resultant database is more uniform and consistent since the extraction and classification process is free of variation from human interpretation.”

Preliminarily, Applicants wish to respond to the assertion in the Advisory Action that “[t]he term “such as” is an open term, and it does not limit the attributes of the desired attributes.”

Brady states, at Column 6, lines 4-8 that, “example documents are resumes of individuals with one or more desired attributes, such as, technical expertise, years of work experience in an industry, academic training (type of degree, institution where degree awarded, grade point average, etc.).” Applicants respectfully disagree with the assertion in the Advisory Action that the term “such as” is an open term that does not limit the attributes of the desired attributes. If use of the term “such as” has any exemplary meaning it must limit the attributes to attributes with the same essential features as what is being exemplified. Any additional exemplary terms must maintain the same essential feature as the initial exemplary terms. In Brady, the exemplary terms given have the essential feature of being data that can be automatically mined from a plurality of resumes accessible over a network. In the present invention, the essential feature of the “desired qualities” is that the “desired qualities” are determined from unique predetermined combinations of the independent characteristics possessed by a candidate. Examples of independent characteristics are given in the instant specification at page 3, line 25 to page 4, line 5, and in Figure 3, and include grade point average greater than 3.5 out of 4.0, multiple degrees, majors, or minors, honor society membership, society office holder or team captain, military service, significant travel exposure, education outside of “home” country, community service participation, tutor experience, among others. As can be seen by comparing the “characteristics” listed in the present invention with the “desired attributes” of Brady, the “desired attributes” are more

clearly related to the “characteristics” of the present invention. For example, the “desired attributes” and the “characteristics” both relate to grade point average, degrees held and majors. Accordingly, the method of the present invention is an improvement over simply mining data from resumes that are accessible over a network, in that the characteristics are combined in a unique combination and normalized to yield the “desired qualities.” Additionally, Applicants respectfully submit that using the term “such as” in a way that does not limit further examples to those having the same essential feature of the exemplary terms destroys the meaning of the term “such as.” For the reasons stated above, Applicants respectfully submit that the “desired attributes” referred to in Brady do not possess the same essential feature of the “desired qualities” of the present invention, and therefore do not exemplify the “desired qualities”.

Additionally, Brady uses the term “such as” in several other instances. For example, at Column 3, line 67 to Column 4, line 8, Brady recites:

For example, data include but are not limited to the following forms, data maybe textual found in various formats, such as, ASCII text, HTML ("links"), XML or the like. The data may also be in the form of a graphics file found in various graphic file formats, such as, JPG, BMP, TIF or the like; or the data may also be in the form of a multimedia file, such as, AVI, MPEG, MOV or the like; or the data may also be in the form of an audio file, such as, WAV, MP3 or the like.

In each instance, when using the term “such as,” Brady gives as examples items that have the same essential feature as the item being exemplified. Textual data is very clearly able to be exemplified by ASCII text, HTML, and XML. Likewise, various graphic file formats are clearly exemplified by JPG, BMP, and TIF. Brady uses “such as” in similar context throughout and each time the examples each have an essential feature common to what is being exemplified. Accordingly, as used by Brady, the term “such as” is not used as an open term that does not limit the attributes of the desired attributes, but rather “such as” limits examples to items having the same essential feature as the exemplified item.

Further, and to the extent understood, no combination of Haq and Brady, considered alone or in combination,, describes or suggests the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. Specifically, Claim 1 recites a method for determining candidates to interview that includes “providing pre-determined desired qualities for a candidate, the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills...determining if the candidate possesses at least one of a plurality of independent characteristics, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...generating a database including at least one characteristic for each candidate wherein the at least one characteristic is correlative to the desired qualities...normalizing the characteristics, normalizing includes comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the desired quality, and assigning a value to each desired quality based on the comparison...displaying results for each candidate based on the desired quality values...selecting at least one candidate to interview based on the desired quality values.”

Neither Haq nor Brady, considered alone or in combination, describes or suggests a method for determining candidates to interview as recited in Claim 1. More specifically, no combination of Haq and Brady, considered alone or in combination, describes or suggests a method for determining candidates to interview that includes providing pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills. Moreover, no combination of Haq and Brady, considered alone or in combination, describes or suggests determining if the candidate possesses at least one of a plurality of independent characteristics wherein a predetermined combination of the characteristics are indicative of a degree to which the candidate possesses the desired qualities. Additionally, no combination of Haq and Brady, considered alone or in combination, describes or suggests generating a database including at least one characteristic for each individual wherein the at least one characteristic is correlative to the desired qualities. Further, no combination of Haq and Brady, considered alone or in combination, describes or suggests normalizing the characteristics wherein normalizing includes comparing a total number of characteristics,

possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the desired quality, and assigning a value to each desired quality based on the comparison. Rather, Haq describes a method of optimizing the assignment of present employees of a company to positions based upon a multi-factored analysis of a database of the employees skills set, and Brady describes a network spider that harvests anonymous information from resumes and other documents found on the network.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Haq. according to the teachings of Brady. More specifically, it is respectfully submitted that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, "it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants'

disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Although it is asserted within the Office Action that Haq teach the present invention except for disclosing desired qualities including at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and that Brady discloses the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, no motivation nor suggestion to combine Brady with Haq has been shown. Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-18 be withdrawn.

Furthermore, Applicants respectfully disagree with the assertion in the Office Action that Brady discloses the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills. Rather, Brady describes automatically harvesting objective information from resumes retrieved from a network via a processor such that "the extraction and classification process is free of variation from human interpretation." The information includes data disclosed in specific fields of a retrieved resume, such as, "technical expertise, years of work experience in an industry, academic training (type of degree, institution where degree awarded, grade point average, etc.)." As such, this information is not "pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills" as recited in Claim 1, but, is rather objective information harvested from a resume. Additionally, as described above, Applicants respectfully submit that the "desired attributes" as recited in Brady, cannot fairly be equated with the "desired qualities" claimed in the present invention because they do not share a common essential feature.

Furthermore, Applicants respectfully submit that no motivation for the combination can be found within Haq and Brady, as Haq and Brady teach away from each other. For

example, in contrast to Brady, Haq describes a method for human resource skill management within a company that uses skill templates to enable a systematic evaluation of that company's own employees' skills to establish the relative suitability of one of the company's employees for a position on a project within the company that is based on a one to one comparison of the employee's skills to a corresponding skill requirement for the position. The documentation of the employees' skill is maintained in a database of known employees. In direct contrast to Haq, Brady describes utilizing a processor to automatically harvest information from publicly available resumes of anonymous persons that are not employees of a particular company.

In contrast to Haq and Brady, the present invention recites, for example at page 3, lines 4-5 that "information pertaining to desired candidate qualities is gathered 44 by assessing a résumé of each candidate submitted." In contrast to this subjective approach to candidate assessment, Haq describes the assessment of employee suitability for a project is based on quantitative evaluation and not on a subjective consideration, and Brady describes that the method is automated and performed by computers and therefore the resultant database is more uniform and consistent since the extraction and classification process is free of variation from human interpretation. Accordingly, Applicants submit that Haq teaches away from Brady, and that the combination of Haq and Brady teaches away from the present invention.

If art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. More specifically, Applicants respectfully submit that Haq teaches away from Brady, and as such, there is no suggestion or motivation to combine Haq with Brady.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Haq in view of Brady.

Claims 2-5 depend from independent Claim 1. When the recitations of Claims 2-5 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-5 likewise are patentable over Haq in view of Brady.

Claim 6 recites a selection system for determining candidates to interview that includes “a database comprising at least one independent characteristic for each candidate, and pre-determined dependent desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills and wherein the at least one characteristic is correlative to the desired qualities, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...a processor programmed to: determine if the candidate possesses the at least one independent characteristic...normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities...display results for each candidate based on the desired quality values.”

Neither Haq nor Brady, considered alone or in combination, describes or suggests a selection system for determining candidates to interview as recited in Claim 6. More specifically, no combination of Haq and Brady, considered alone or in combination, describes or suggests a selection system for determining candidates to interview that includes a database including at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills and wherein the at least one characteristic is correlative to the desired qualities and wherein a predetermined combination of the characteristics is indicative of a degree to which the candidate possesses the desired qualities. Moreover, neither Haq nor Brady, considered alone or in combination, describes or suggests a processor programmed to normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality. Furthermore, neither Haq nor Brady, considered alone or in combination, describes or suggests a processor programmed to display results for each candidate based on the desired quality values. Rather, Haq describes a method of optimizing the assignment of present employees of a company to positions based upon a multi-factored analysis of a database of the employees skills set, and Brady describes

a network spider that harvests anonymous information from resumes and other documents found on the network.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 6 is patentable over Haq in view of Brady.

Claims 7-11 depend, directly or indirectly, from independent Claim 6. When the recitations of Claims 7-11 are considered in combination with the recitations of Claim 6, Applicants submit that dependent Claims 7-11 likewise are patentable over Haq.

Claim 12 recites an apparatus for screening candidates to interview that includes a processor having a memory and programmed to “a processor comprising a memory and programmed to “generate a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and wherein the at least one characteristic is correlative to the desired qualities, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...determine if the candidate possesses the at least one independent characteristic...normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities...display results for each candidate based on the desired quality values.”

Neither Haq nor Brady, considered alone or in combination, describes or suggests an apparatus for screening candidates to interview as recited in Claim 12. More specifically, no combination of Haq and Brady, considered alone or in combination, describes or suggests an apparatus for screening candidates to interview that includes a database having at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and wherein the at least one characteristic is correlative to the desired qualities, wherein a predetermined combination of characteristics is indicative of a degree to which the candidate possesses the desired qualities. Moreover, no combination of Haq and Brady, considered alone or in combination, describes

or suggests a processor programmed to normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities. Further, neither Haq and Brady, considered alone or in combination, describes or suggests a processor programmed to display results for each candidate based on the desired quality values. Rather, Haq describes a method of optimizing the assignment of employees to positions based upon a multi-factored analysis and database. Although Haq discusses a system that enables employees to assess what specific skills are needed to perform a job function, and Brady describes a system for harvesting resumes from a network of documents and extracting information from specific fields, neither Haq nor Brady describes or suggests a database having pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, nor at least one characteristic that is correlative to the desired qualities and wherein a predetermined combination of characteristics is indicative of a degree to which the candidate possesses the desired qualities.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 12 is patentable over Haq in view of Brady.

Claims 13-18 depend, directly or indirectly, from independent Claim 12. When the recitations of Claims 13-18 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claims 13-18 likewise are patentable over Haq in view of Brady.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 1-18 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'R. B. Reaser III', is written over a horizontal line.

Robert B. Reaser III
Registration No. 45,548
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070